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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,908	03/17/2005	Tze Chein Wun	60020830-0004	5630
26263 7590 10/22/2007 SONNENSCHN NATH & ROSENTHAL LLP P.O. BOX 061080 WACKER DRIVE STATION, SEARS TOWER CHICAGO, IL 60606-1080			EXAMINER MONSHIPOURI, MARYAM	
			ART UNIT 1656	PAPER NUMBER
			MAIL DATE 10/22/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/516,908	Applicant(s) WUN, TZE CHEIN	
	Examiner Maryam Monshipouri	Art Unit 1656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
 4a) Of the above claim(s) 7-9 and 11-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-6, 10 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

Applicant's response to restriction requirement filed 8/22/2007 is acknowledged. Applicant elected Group I (claims 1-6 and 10) with traverse. Claims 7-9, 11-23 are hereby withdrawn as drawn to non-elected invention. In traversal of restriction requirement applicant argues the following: That Group II serves as a template for the protein of Group I and thus it is very likely that the information concerning both of these Groups will be discovered while searching one of these Groups, imposing no undue burden of extra searching on the examiner. Hence restriction between Groups I-II should be withdrawn.

This argument was fully considered but was found **unpersuasive**. As stated by the previous examiner of record the special technical feature of Group I invention is the anticoagulant protein which lacks any similarity or function with the special technical feature of Group II, being the DNA. While the examiner agrees that there may be some overlap between searches required for each invention she maintains that said searches are not **coextensive**. This is because, as applicant is well aware, while one searches for DNA sequences in commercial and in-house data bases one does not look for their expression products because said expression products are irrelevant to the DNA sequences. Therefore, for said reason

rejoinder of Groups I-II does impose an undue burden of searching on the examiner and restriction remains for the reasons of record.

Upon review of the previous restriction letter, drafted by a different examiner, further restriction deemed necessary as following:

Group I(a): claims 1-6, drawn to a recombinant anticoagulant protein and a method of inhibiting blood coagulation utilizing said protein.

Group I(b): claim 10, drawn to a method of treating or preventing an excess thrombotic activity in a subject utilizing said protein.

The inventions of Groups I(a)-I(b) share a special technical feature namely anticoagulant protein. However, said inventions are not required to be rejoined under PCT rule 13.1 because Group I(a) already has a method of use of said protein.

Additionally each of the inventions of Groups I(a), I(b) and II are directed to the **following 4 distinct species** of unrelated structure:

- (1) SEQ ID NO:1 or DNA encoding it.
- (2) SEQ ID NO:2 or DNA encoding it.
- (3) SEQ ID NO:3 or DNA encoding it.
- (4) SEQ ID NO:4 or DNA encoding it.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species from Groups 1-4 above or invention from Groups I(a-b) above to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maryam Monshipouri whose

telephone number is (571) 272-0932. The examiner can normally be reached on Tues.-Fri., from 7:00 a.m to 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleene Kerr Bragdon can be reached on (571) 272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

re. Monship
Maryam Monshipouri Ph.D.

Primary Examiner
